



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/056,101      | 01/24/2002  | Leonard Marotta      | MAROTTA-ANALOG      | 9440             |

4988 7590 04/22/2005

ALFRED M. WALKER  
225 OLD COUNTRY ROAD  
MELVILLE, NY 11747-2712

|          |
|----------|
| EXAMINER |
|----------|

LEWIS, RALPH A

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3732

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                  |  |
|------------------------------|-------------------------------|----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/056,101 | Applicant(s)<br>MAROTTA, LEONARD |  |
|                              | Examiner<br>Ralph A. Lewis    | Art Unit<br>3732                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12,14-17,19,21-24,30,32-35 and 38-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12,14-17,19,21-24,30,32-35 and 38-41 is/are allowed.
- 6) ☒ Claim(s) 42-76,78 and 79 is/are rejected.
- 7) ☒ Claim(s) 77 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner. *(Informal - FORMAL REQ'D)*  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

### **Finality of Previous Office Action Withdrawn**

The examiner in a telephone conversation with applicant on January 5, 2005 indicated that the first action finality of the Office Action of 07/02/2004 would be withdrawn to permit applicant to add additional claims.

### **Rejections based on 35 U.S.C. 112, second paragraph**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 56-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 56, step "a" doesn't make any sense. In line 3, there is no antecedent basis for "said pin." In line 4, there is no antecedent basis for "said plurality."

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42-44, 50-57, 60 and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Sutter (WO 98/52490) (note US 6,332,777 B1 is relied upon herein as an accurate translation of the PCT application).

In Figure 1, note analog post 50 that is to be imbedded in plaster. The post includes projections between identified elements 60. Some of the projections are orthogonal to one another and not parallel. It is noted that while in the Sutter Figure 1 the analog post is illustrated with projections at the top end, the ordinarily skilled artisan would readily recognize that the device when used for a tooth in the upper jaw would have the projections at the "bottom end" assuming the patient was sitting/standing upright. In regard to claim 44, a circle is an ellipse by definition. In regard to claim 52, the projections of Sutter could be referred to as "rods."

Claims 42-44, 50, 52-56, 59-63, 69, 71-75, 78 and 79 are rejected under 35 U.S.C. 102(b) as being anticipated by Ziegler (US 5,829,981).

Ziegler discloses an analog post comprised of an elongated pin 14 with anti-rotation projections 16 extending from an end thereof. The some of the projections are angled with respect to one another and are not parallel. In regard to claim 44, a circle is an ellipse by definition. In regard to claim 52, the projections of Sutter could be referred to as "rods."

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42-57, 60 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter (WO 98/52490) (note US 6,332,77 B1 is relied upon herein as an accurate translation of the PCT application).

In regard to claims 44-49, Sutter discloses a circular cross-section for the pin rather than the variety of different geometric cross-sections set forth in the present claims by applicant. One of ordinary skill in the art, however, would have found it obvious to have used other common geometric configurations for the cross-section of the Sutter pin as a matter of routine design.

To the extent that applicant's "analog post" limitation requires an interpretation that the "analog post" is representative of the implant, Sutter discloses such a post 263 (Figures 11-14) having anti-rotation projections 266 extending radially therefrom for fixing the post in the dental mold. Sutter does not appear to explicitly disclose that these projections 266 (illustrated schematically) can be designed as those projections shown at 60 in Figure 1. One of ordinary skill in the art, however, would have readily found that the design of the projections 60 for preventing rotation could obviously be applied to the projections 266 in order to prevent rotation.

Claims 44-49 and 63-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziegler (US 5,829,981).

In regard to claims 44-49 and 63-68, Ziegler discloses a circular cross-section for the pin rather than the variety of different geometric cross-sections set forth in the present claims by applicant. One of ordinary skill in the art, however, would have found it obvious to have used other common geometric configurations for the cross-section of the Ziegler pin as a matter of routine design.

Claims 70 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ziegler (US 5,829,981) in view of Sutter (WO 98/52490) (note US 6,332,77 B1 is relied upon herein as an accurate translation of the PCT application).

In Ziegler the projections 16 are not longitudinally spaced from one another as claimed. Sutter, however, teaches the providing of longitudinally spaced projections which would clearly provide for better anchoring in the plaster. To have added longitudinally spaced projections to the Ziegler post in order to improve its anchoring in the plaster would have been obvious to one of ordinary skill in the art.

#### **Allowable Subject Matter**

Claims 12, 14-17, 19, 21-24, 30, 32-35 and 38-41 are allowed.

Claim 58 would be allowable if rewritten in independent form to include all of the limitations of the claims from which it depends and to overcome the 35 U.S.C. 112, second paragraph rejection above.

Claim 77 is objected to as being written on a rejected base claim but would be allowable if rewritten in independent form to include all of the limitations of the claims from which it depends.


**Action Made Final**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis  
April 18, 2005

  
Ralph A. Lewis  
Primary Examiner  
AU 3732